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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,379	02/28/2002	Akemi Hirotsune	H&A-108	1244

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EXAMINER

AUGUSTIN, EVENS J

ART UNIT PAPER NUMBER

3621

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/084,379

Applicant(s)

HIROTSUNE ET AL.

Examiner

Evans Augustin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner. .
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Status of Claims

1. Claims 1-16 have been examined.

Claim Rejections - 35 USC § 112

2. Claims 3 and 10 recite the limitation "said allocation information" in claim 1. There is insufficient antecedent basis for this limitation in the claim.
3. Claims 5, 8 recite the limitation "said prescribed information" in claim 1. There is insufficient antecedent basis for this limitation in the claim.
4. Claim 15 recites the limitation "said allocation information" in claim 13. There is insufficient antecedent basis for this limitation in the claim.
5. Regarding claims 3 and 7, the phrases "recording... on software" and "recorded on software" render the claims indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. According to Computer Dictionary by Microsoft Press, software is computer programs; instructions that make hardware work. Accordingly, it would not be possible for information to be recorded on software

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1-10 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al. (U.S 6,742,147), in view of Dimitri et al. (U.S 6,574,424).

As per claims 1-10 and 12-16, Sasaki et al. discloses a recording medium, method and apparatus which includes:

- A recording medium/optical disk such as a DVD-RAM (column 8, line 26) with a disk information area, a user area including a plurality of sectors (recording limiting area) and a spare area, capable of storing information. The recording or reproduction is done on a sector-by-sector basis (column 8, lines 27-28). The spare area is used when one of the other areas is considered defective (column 4, lines 1-5) or an error has occurred in reading the sector address (column 13, lines 14-16)
- Displaying information on a screen (column 7, lines 55-57)
- File allocation table within the data recording area (column 9, lines 4-6), containing location information, indicating locations of files and directories in the file data area and indicating locations of empty areas (column 9, lines 20-22)
- Detecting a defective sector included in the user area (column 5, lines 24-25)
- The file allocation table is read from the optical disk by recording and reproduction apparatus before recording (column 16, lines 1-5). An area is considered defective if an error has occurred in reading the sector address (column 13, lines 14-16)

Sasaki et al. does not teach a recording medium with pre-recording data, such as advertisement. However, Dimitri et al. teaches a method for storing commercials on DVDs (column 6, lines 18-28). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to pre-record advertisements on an optical disk.

It would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to pre-record advertisements on an optical disk because it would reduce the costs involved in making the disks (column 2, lines 4-6), and it would provide a new platform to advertise to the captive customers of optical disks.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al. (U.S. 6,742,147) and Dimitri et al. (U.S. 6,574,424), in view of Ueseka et al. (US 6,044,157).

As per claim 11, Sasaki et al. and Dimitri et al.'s inventions have previously been disclosed above.

Sasaki et al. and Dimitri et al. did not explicitly describe a method/system in which data recorded on an optical disk is encrypted. However, Ueseka et al. describes a method/system that teaches encrypted data from an optical disk such as DVD (column 20, lines 11-12). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to encrypt pre-recorded data on an optical disk because it prevent piracy of the disks (column 4, line 56) by enabling the prohibition of illegal copies and malfunctions to be achieved (column 6, lines 51-52).

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ando et al. (US 6,505,964)
- Fujisawa et al. (US 6,804,181)

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2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 703-305-0267. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammel can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(703) 305 – 5532 (for formal communications intended for entry and after-final communications), or (703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Evens J. Augustin
Art Unit 3621



JAMES P. TRAMMELL
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